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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,091	09/04/2003	James J. LeKachman	47004.000216	5822
21967 7590 05/24/2010 HUNTON & WILLIAMS LLP INTELLECTUAL PROPERTY DEPARTMENT 1900 K STREET, N.W. SUITE 1200 WASHINGTON, DC 20006-1109				
			EXAMINER	
			TRAN, HAI	
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			3694	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/654,091

**Applicant(s)**

LEKACHMAN, JAMES J.

**Examiner**

HAI TRAN

**Art Unit**

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

##### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 15, 2010 has been entered.
2. This communication is in response to the Amendments/Remarks filed on April 15, 2010, for application, titled: "System and Method for Financial Instrument Pre-Qualification and Offering".

##### ***Status of the Claims***

3. Claims 1, 12, 14, and 31 have been amended. Accordingly, claims 1-31 remain pending and have been examined.

##### ***Priority***

4. This application claims the benefit of U.S. Provisional Patent Application No. 60/407,696, filed on 09/04/2002.

***Information Disclosure Statement***

5. The information disclosure statements (IDS) filed on 6/8/09, 2/13/04, 1/30/04, and 11/6/03 included too much information. For example, the IDS filed on 6/8/09 alone has 719 items.
6. Applicant is requested to point out which references are more specifically relevant to the invention, so that they can be considered as to the merits.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
9. Claims 1-13 are rejected under 35 U.S.C. 101. Applicant recites "A system ... comprising:", however, there does not appear to be any computer related hardware or devices or specific structure in the body of the claim. Applicant recites "receiving unit", "interface", "consumer database", and "suppression database" in the body of the claim. A "receiving unit" and an "interface" are defined as software that enables a program to work with a user and a "database" is computer program for managing electronic data which are software. Software alone in an apparatus claim prevents the claim from falling into one of the statutory categories of invention (see MPEP 2106.01).

10. Claim 3 is rejected under 35 U.S.C. 101. Applicant recites "a human operator" which is not a system and does not fall into one of the four statutory categories of invention (see MPEP 2106.01).

11. Claims 14-31 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

Here, Applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 14-31 are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101. Note the Board of Patent Appeals Informative Opinion *Ex parte* Langemyr.

### ***Claim Rejections - 35 USC § 112***

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
14. Claim 3 recites the first interface unit is "a human operator" but claim 4 recites the first interface unit is "a computer telephone interface" is unclear if the first interface unit is a human operator or a telephone interface. The metes and bounds of the claims cannot be understood because of the lack of definiteness in the claims. Appropriate correction is required.

### ***Response to Arguments***

15. Applicant's arguments filed 04/15/2010 have been fully considered but they are not persuasive.
16. Applicant argues Jones and Cunningham, either singly or in combination, fail to teach or suggest "the consumer information being received prior to a consumer contact" (see Remarks, page 12).
17. The Examiner respectfully disagrees and would like to point the Applicant to Jones, column 2, lines 43-50, column 3, lines 22-24, and column 4, lines 25-28:

"a method and associated apparatus is provided for determining the approval status of a potential borrower, including whether the potential borrower is pre-approved or pre-qualified for a loan, in which unnecessary disclosure of sensitive information to persons, such as product dealers, regarding a potential borrower's ability to obtain a loan is not required."

"automatically transmitting information regarding the approval status of the potential borrower to the lender"

"Pre-approved" means that the borrower, except for verification of certain information, is approved for a loan of a specified amount."

18. As it can be seen in the cited information above in Jones, the consumer information is received by the lender prior to consumer makes a contact. Hence, the Examiner decides to maintain the rejections of all claims.

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al. (U.S. Patent No. 5,797,133) ("Jones") in view of Cunningham (U.S. Patent No. 7,310,617) ("Cunningham").

21. **As per claim 14**, Jones teaches a method for offering financial instruments to pre-qualified consumers (see Jones, col. 4, lines 18-54), comprising:

receiving information related to personal identification information associated with a consumer who is a customer of at least one of a financial institution and an entity associated with the financial institution, the consumer personal identification information being received prior to a consumer contact (see Jones, col. 5, lines 5-59, Figure 1);

inquiring a third party based on the received information related to the consumer personal identification information whether the consumer has been pre-qualified for a financial instrument, the financial instrument associated with the financial institution,

wherein the pre-qualification is based at least in part on a first consumer file (see Jones, col. 3, lines 37-42 "pre-approve or pre-qualify", col. 5, lines 66-5 of col. 6 "financial information stored in the credit bureau data processing system", Figure 2/block 52-60);

receiving pre-qualification data from the third party wherein the pre-qualification data relates to a determination of whether a consumer identifier associated with the consumer is contained in a suppression database (see Jones, col. 6, lines 2 "potential borrower's social security number to extract financial information stored in credit bureau data processing system"), wherein the suppression database comprises a plurality of second consumer files, each of the second consumer files linked to a unique consumer identifier, wherein the second consumer files comprise suppression information relating to a determination that the consumer associated with the second consumer file is no longer qualified to be offered one or more of the pre-qualified financial instruments stored in the first consumer file (see Jones, col. 6, lines 29-48 "approved, rejected, not determined", Figure 2/blocks 62-66);

requesting data periodically for requalification of the consumer prior to a consumer contact to reduce a likelihood of offering a financial instrument for which a consumer is no longer qualified (see Jones, col. 2, lines 43-50, col. 3, lines 22-24, and col. 4, lines 25-28); and

offering the consumer the financial instrument for which he or she is pre-qualified, if the received pre-qualification data from the third party indicates that the consumer is pre-qualified for a financial instrument (see Jones, col. 6, lines 64-32 of col. 7, Figure 2/blocks 62, 76-82),



wherein the standards for the consumer pre-qualification are set by the financial institution (see Cunningham, col. 4, lines 22-67 "grade/score combination"; Figure 2/blocks 48-50, Jones, col. 3, lines 5-10 "(11) according to criteria provided by a lender", col. 6, lines 29-30 "lender's lending criteria is accessed").

Jones teaches a system and method for automatically determining the approval status of a potential borrower of a loan including whether the potential borrower is pre-approved or pre-qualified for a loan. Jones discloses the "criteria" provided by a lender (see col. 3, lines 5-10, col. 6, lines 29-30), but does not explicitly disclose the standards for the consumer pre-qualification associated with financial institutions.

Cunningham teaches a method and system for presenting financial card offers to potential customers including the financial institution's selection standards (see col. 4, lines 32-35).

It would have been obvious to one of ordinary skill in the art at the time of the invention to include the financial institution selection criteria (or standards for consumer pre-qualification set by financial institutions) as taught by Cunningham into the automatic loan system/method for pre-approved or pre-qualified potential borrower as taught by Jones and as both Jones and Cunningham are directed toward the field of offering financial instruments (credit cards, loans) to potential pre-qualified/pre-approved consumers, no unpredicted results are expected.

22. **As per claim 15**, Jones and Cunningham teach the method of claim 14.

Jones teaches wherein pre-qualification of the consumer comprises checking at least one of the credit rating of the consumer, the income level of the consumer, the debt level of the consumer and the payment history of the consumer with the financial institution (see Jones, col. 5, lines 39-42, 66-67, col. 6, lines 21-27).

23. **As per claim 16**, Jones and Cunningham teach the method of claim 15.

Jones teaches wherein pre-qualification of the consumer occurs prior to receipt of the consumer personal identification information (see Jones, col. 2, lines 43-50, col. 3, lines 22-24, and col. 4, lines 25-28).

24. **As per claims 17-18**, Jones and Cunningham teach the method of claim 16.

Jones teaches wherein the third party maintains consumer information in files indexed by a unique identifier, and wherein the unique identifier relates to the personal identification information of the consumer (see Jones, col. 3, lines 14-16).

25. **As per claim 19**, Jones and Cunningham teach the method of claim 18.

Jones teaches further comprising offering the financial instrument to the consumer only if the consumer credit rating meets or exceeds a pre-determined condition (see Jones, col. 6, lines 29-42).

26. **As per claims 20-21**, Jones and Cunningham teach the method of claim 19.

Jones teaches wherein the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive, and wherein the financial instrument comprises at least one of a car loan, boat loan, loan on investment property, margin account, business loan, second mortgage, home equity line of credit, consumer loan, transaction card, credit card, loyalty card, co-branded credit card, debit card, rewards card, smart card, mutual fund or insurance (see Jones, col.3 lines 58-60 "mortgage").

27. **As per claim 22**, Jones and Cunningham teach the method of claim 21.

Jones teaches wherein the consumer is offered the financial instrument only if one or more pre-determined conditions are met (see Jones, col. 6, lines 29-42).

28. **As per claim 23**, Jones and Cunningham teach the method of claim 22.

Cunningham teaches wherein the consumer personal identification information is obtained when the consumer makes contact comprises a purchase from a merchant (see Cunningham, col. 4, lines 13-15 "the process begins when a user completes an application by providing personal and financial information"). The Examiner notes that Cunningham does not expressly disclose "a purchase from a merchant". However, it would not have made any difference since the purpose of this claim is to obtain the consumer personal identification information, Cunningham's teachings includes obtaining personal and financial information (see col. 4, lines 7-21). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the

teachings of Jones with Cunningham to provide an improved automatic loan system/method for pre-approved and pre-qualified potential borrower.

29. **As per claim 24**, Jones and Cunningham teach the method of claim 22.

Cunningham teaches wherein the consumer personal identification information is obtained through contact comprises one of a communication from a business partner of the financial institution or a communication directly to the financial institution (see Cunningham, col. 4, lines 7-20 "the process begins when an applicant completes an application"; Figure 2/elements 40-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Jones with Cunningham to provide an improved automatic loan system/method for pre-approved and pre-qualified potential borrower.

30. **As per claim 25**, Jones and Cunningham teach the method of claim 24.

Jones teaches wherein consumer personal identification information is obtained through a telephone call or contact over a computer network (see Jones, col. 5, lines 6-13).

31. **As per claim 26**, Jones and Cunningham teach the method of claim 25.

Jones teaches further comprising offering the financial instrument only upon the acceptance of any terms and conditions related to the financial instrument by the consumer (see Jones, col. 6, lines 67-8 of col. 7 "notice letter").

32. **As per claim 27**, Jones and Cunningham teach the method of claim 25.

Jones teaches further comprising offering the financial instrument to the consumer only if the identity of the consumer is authenticated (see Jones, col. 5, lines 36-43; col. 6, lines 1-5).

33. **As per claim 28**, Jones and Cunningham teach the method of claim 27.

Jones teaches wherein authenticating the consumer comprises favorable comparison of stored consumer information to consumer personal identification information (see Jones, col. 6, lines 1-5).

34. **As per claim 29**, Jones and Cunningham teach the method of claim 28.

Jones teaches wherein the consumer personal identification information comprises at least one of a calling telephone number, a PIN, a password, a biometric or any other information known or held by the consumer and generally not known to the public that can be used to authenticate the consumer (see Jones, col. 5, lines 35-42).

35. **As per claim 30**, Jones and Cunningham teach the method of claim 28.

Jones teaches wherein authentication is performed by the third party (see Jones, col. 6, lines 51-53 "determine whether the potential borrower is pre-approved or rejected based upon the predetermined information and/or information from the credit bureau").

36. **As per claim 31**, this claim is similar to claim 14 except that it includes the limitation of "wherein further the financial instrument comprises any financial instrument for which credit information relating to the consumer is predictive" which is the limitation in claim 20. Hence, this claim is rejected under the same rationale provided in claims 14 and 20 (see discussion in claims 20-21 above).

37. **As per claim 1**, this claim is similar to claim 14 except that it includes the interface units for receiving data, database for managing data, and the limitation of "wherein the pre-qualification data relates to at least one financial instrument associated with ..." (see Jones, col. 3, lines 4-31 "lender criteria", col. 6, lines 2-27 "borrower's social security number", "passwords and/or commands"). Hence, it is rejected under the rationale provided in claim 14.

38. **As per claim 2**, this claim corresponds to claims 17 and 18. Hence, it is rejected under the rationale provided in claims 17 and 18.

39. **As per claim 3**, this claim corresponds to claim 25. Hence, it is rejected under the rationale provided in claim 25.

40. **As per claim 4**, this claim corresponds to claim 25. Hence, it is rejected under the rationale provided in claim 25.

41. **As per claims 5-6**, these claims correspond to claim 27. Hence, they are rejected under the rationale provided in claim 27.
42. **As per claim 7**, this claim corresponds to claim 29. Hence, it is rejected under the rationale provided in claim 29.
43. **As per claim 8**, this claim corresponds to claim 27. Hence, it is rejected under the rationale provided in claim 27.
44. **As per claim 9**, this claim corresponds to claim 15. Hence, it is rejected under the rationale provided in claim 15.
45. **As per claim 10**, this claim corresponds to claim 19. Hence, it is rejected under the rationale provided in claim 19.
46. **As per claim 11**, this claim corresponds to claim 26. Hence, it is rejected under the rationale provided in claim 26.
47. **As per claim 12**, this claim is similar to claim 31 except that it includes the limitation of 'where a consumer having a unique identifier ...that is linked to the unique identifier of the consumer' which is the limitation in claims 17 and 18. Hence, it is rejected under the rationale provided in claims 31, 17, and 18.

***Conclusion***

48. Claims 1-31 are rejected.

49. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAI TRAN whose telephone number is (571)272-7364. The examiner can normally be reached on M-F, 9-4 PM.

50. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

51. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hai Tran/  
Examiner, Art Unit 3694